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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,672	08/24/2001	Ronald D. Blum	10551/213	3424
23838	7590	12/08/2003	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			CHIN, RANDALL E	
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/935,672

Applicant(s)

BLUM ET AL.

Examiner

Randall Chin

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 16, 17, 19, 20, 26 and 28-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-15, 18, 21-25, 27 and 39-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 1-11, 16, 17, 19, 20, 26 and 28-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed October 29, 2003.

Applicant's election of Figs. 23, 24C, 24D, 24E, 26B, 26C, 26D, claims 12-15, 18, 19, 21-25, 27 and 39-47 in the paper filed October 29, 2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claim 19, indicated by Applicant as readable on the elected invention, is being withdrawn from consideration since claim 19 depends on non-elected claim 16.

### *Specification*

3. The disclosure is objected to because of the following informalities: The specification, particularly the "Brief Description of the Drawings" section on p.6 and the "Detailed Description" section on p. 30 refer to a "Fig. 23", however, the drawing figures include a "Fig. 23A" and "Fig. 23B". Consistent labeling in the drawings and specification is respectfully requested here for a clear explanation of the invention. For example, in paragraph [0139], the recitation "cross-sectional view 23-23" appears to

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refer to Fig. 23A. There appears to be no "cross-sectional view 23-23" labeled in the drawings.

Appropriate correction is required.

4. The oath or declaration is should be clarified to accurately reflect the continuity data referred to on the first page of the specification. An "Application Data Sheet" may be submitted. Presently, the oath appears to only refer to U.S. Application Serial No. 60/227,596.

Furthermore, the "Assignment and Agreement" does not include the signature of inventor Dwight P. Duston.

5. Clarification is respectfully requested in claims 18 and 21 since independent claim 12 is merely claiming a "tacky insert". Claims 18 and 21 recite "said base portion" and such recitation is inconsistent with that recited in independent claim 12 which is merely claiming a "tacky insert".

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 12-14, 22, 23, 25, 27 and 44-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Amos 3,785,102 (hereinafter Amos '102).

With respect to claim 12, the patent to Amos '102 teaches a tacky insert (Fig. 2) which is still "configured to be received within a recess of a floor mat". Claim 12 is merely claiming a "tacky insert" and never positively claims the structure of the floor mat itself, for example, the "recess". The fact that Amos' assembly or pad 15 shown in Fig. 2 is intended to stand alone (i.e., without being positioned in any floor mat recess), is patentably irrelevant for purposes of rejecting claim 12 since the structure of Amos' invention meets the claimed limitations. Thus, with respect to claim 12, Fig. 2 of Amos '102 clearly discloses a "tacky insert" 15 which comprises at least a sheet 16 and which sheet 16 is a layer of flexible material having a tacky surface.

As for claim 13, Amos '102 teaches that the tacky insert could be "colored" (col. 4, lines 33-34) and therefore is deemed to be a "color grain". Furthermore, Amos '102 recites that a sheet or tacky insert can be imprinted with a decorative design (col. 4, lines 35-36) thus constituting a "pre-selected pattern".

As for claim 14, the tacky insert can also be transparent (col. 4, line 34-35).

With respect to claim 22, Amos '102 also teaches that the "tacky insert" 15 could comprise a plurality of separate layers (Fig. 2).

As for claim 23, each sheet 16 has a "portion" or remove tab 18 (Fig. 3) for separating it from others of the layers.

As for claim 25, each layer comprises an adhesive layer 17 and a film layer 16 (Fig. 2).

With respect to claim 27, since Amos '102 recites that the "bottom sheet" or "all of them" could be colored or have an imprinted decorative design thereon, then a base layer of the layers has at least one of a pre-selected pattern and color grain (col. 4, lines 33-36).

With respect to claim 44, since the sheet 16 can be polyethylene or polypropylene, the material includes a hydrophobic substance. Along similar lines, the material is deemed to therefore include a water-dissipating property as recited in claim 45.

As for claim 46, the remove tab 18 is not tacky (col. 4, lines 45-46).

As for claim 47, since Amos '102 recites that the assembled stack is beveled on all four sides (col. 6, lines 21-22 and Fig. 2), the remove tabs 18 of the layers are deemed to be layered in a graduated fashion.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amos '102.

As for claims 39 and 40, Amos '102 already teaches that the material could be polyethylene or polypropylene (col. 4, lines 12-15). With respect to the polyethylene

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being "low-density" or the polypropylene being "bi-axially oriented," it is the Examiner's position that such choices are within the level of ordinary skill to select in order to optimize desired adhesion characteristics relative to foot traffic as well as dirt retention or pick-up.

As for claim 41, polyester is a well known material and could be selected by one of ordinary skill either for a fibrous or plastic film or sheet depending on desired features for a floor mat.

10. Claims 12, 22-25, 46 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by De Guzman 4,917,975 (hereinafter De Guzman '975).

With respect to claim 12, the patent to De Guzman '975 teaches a tacky insert (Figs. 1 and 2) which is still "configured to be received within a recess of a floor mat". Claim 12 is merely claiming a "tacky insert" and never positively claims the structure of the floor mat itself, for example, the "recess". The fact that De Guzman's assembly or mat 20 is intended to attach to a roller (i.e., without being positioned in any floor mat recess), is patentably irrelevant for purposes of rejecting claim 12 since the structure of De Guzman '975 meets the claimed limitations. Thus, with respect to claim 12, Figs. 1 and 2 of De Guzman '975 clearly discloses a "tacky insert" which comprises at least a sheet 22 and which sheet 22 is a layer of flexible material having a tacky surface.

With respect to claim 22, the "tacky insert" could comprise a plurality of separate layers (Figs. 1 and 2).

As for claim 23, each sheet 22 has a remove tab 28 for separating it from others of the layers.

As for claim 24, the tabs 28 are numbered (Figs. 1 and 2).

As for claim 25, each layer comprises an adhesive layer 26 and a film layer.

As for claim 46, the remove tab 28 is not tacky (col. 3, line 30-33).

As for claim 47, the remove tabs 28 of the layers are layered in a graduated fashion (Figs. 1 and 2).

11. Claims 12, 13, 18, 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Converse 2,800,215 (hereinafter Converse '215).

With respect to claim 12, the patent to Converse '215 teaches a tacky insert (Fig. 1) which can be "configured to be received within a recess of a floor mat". Claim 12 is merely claiming a "tacky insert" and thus the recitation of a floor mat or recess of a floor mat is patentably irrelevant since neither is ever positively claimed. Thus, with respect to claim 12, Converse '215 clearly discloses a "tacky insert" (Fig. 1) which comprises at least a sheet 10 and which sheet 10 is a layer of flexible material having a tacky surface 12 (col. 2, lines 50-51).

As for claim 13, Converse '215 teaches that the tacky insert 10 can have a creped surface (col. 2, lines 45-47 and shown in Fig. 1) thus constituting a "pre-selected pattern".



As for claim 18, the tacky insert 10 has an adhesive undersurface 11 for securing the tacky insert to a base portion, and a protective strip or release layer 15 for covering the adhesive undersurface (col. 2, lines 47-52 and col. 3, lines 44-48 and Fig. 1).

As for claim 42, the material includes paper (col. 2, lines 45-46). It follows that the material includes a hydrophilic substance as recited in claim 43.

12. Claims 12, 15 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Calhoun 5,589,246 (hereinafter Calhoun '246).

With respect to claim 12, the patent to Calhoun '246 teaches a "tacky insert" (Fig. 1) which can be "configured to be received within a recess of a floor mat". Claim 12 is merely claiming a "tacky insert" and thus the recitation of a floor mat or recess of a floor mat is patentably irrelevant since neither is ever positively claimed. Thus, with respect to claim 12, Calhoun '246 clearly discloses a "tacky insert" which comprises at least a sheet 11 which sheet is a layer of flexible material having a tacky surface 16 (col. 6, lines 40-47).

As for claim 15, the tacky insert is deemed to have apertures therein in the final product (for protrusions 18 in Fig. 1).

As for claim 21, the tacky insert is deemed to have notches spaced therein in the final product (for protrusions 18 in Fig. 1). No patentable weight has been given to "alignment protrusions of said base portion" for aligning purposes since claim 12 is merely claiming a "tacky insert".

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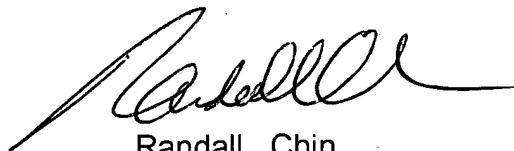
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (703) 308-1613. The examiner can normally be reached on Monday through Thursday and every other Friday. **A scheduled move is set for December 16-17, 2003 and the Examiner can then be reached at new telephone number (571) 272-1270.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on (703) 308-2920. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



R. Chin



Randall Chin  
Primary Examiner  
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